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AUG 24 2005

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In re Application of :
Jean-Christophe F. Audonnet et al :
Serial No.: 09/677,672 : PETITION DECISION
Filed: October 2, 2000 :
Attorney Docket No.: 574313-3160 :

This is in response to the petition under 37 CFR 1.181, filed June 1, 2005, requesting withdrawal of the Final rejection, mailed April 23, 2004.

BACKGROUND

A review of the file history shows that the examiner mailed a Final Office action to applicants on April 23, 2004, (not April 25, 2004, as stated in the petition) setting a three month shortened statutory period for reply. Claims 1-2, 4 and 10-12 were again rejected under 35 U.S.C. 102(e) as anticipated by Ross et al. Claims 1-19 were rejected over any of Davis, Olsen or Crabb in view of any of Miles, Inc., Lowell, Chavez, Gicquel or Wasmoen. The action was made Final in view of the rejections having been set forth in the previous Office action.

Applicants replied on October 25, 2004 (Monday), amending claims 1, 10, 13 and 19 and canceling claims 2-4, 7-9, 11-12 and 14-18, and requesting a three month extension of time and fee therefor. Applicants submitted a copy of the priority document to overcome the rejection over Ross et al. and addressed the rejection under 35 U.S.C. 103(a) and requested an interview. Applicants also provided an unexecuted opinion declaration under 37 CFR 1.132 by inventor Audonnet. Applicants concurrently filed a Notice of Appeal.

The examiner mailed an Advisory Action to applicants on November 8, 2004, indicating entry of the amendment and withdrawal of the 35 U.S.C. 102(e) rejection based on submission of the priority document. Evaluation of the affidavit was not made as it was unexecuted.

Applicants filed the executed declaration on November 12, 2005, however the examiner was never apprised of its submission. Applicants then filed RCE papers on June 1, 2005, including a request and fee for a five month extension of time. In response, the examiner has now allowed the application.

DISCUSSION

Applicants request withdrawal of the finality of the Office action of April 23, 2004, and refund of fees paid with the filing of the RCE papers, including the extension of time fee due to Office failure to timely address the communication filed November 12, 2004.

The request to withdraw finality will not be granted as the Office action was properly made Final. Applicants do not dispute that the Office action was a proper Final Office action and give no reason that the Office action was improperly made Final. Therefor, finality will not be withdrawn.

While it is regretted that the examiner was not aware of the submission of the executed declaration until several months after its submission which caused a failure to act on it in a timely manner, applicants remained under an obligation to take action following the filing of the Notice of Appeal by either filing an Appeal Brief or RCE papers (or an amendment which placed the application in condition for allowance). As there is no guarantee that an amendment will place an application in condition for allowance applicants remained under obligation to take other action in a timely manner. In order to ensure consideration of the executed declaration when no communication from the Office was received in a timely manner a telephone interview should have been initiated. Such would have avoided the necessity of filing RCE papers at the last minute in order to ensure consideration of the executed declaration. Further, inasmuch as the executed declaration itself did not place the application in immediate condition for allowance without an examiner's amendment, filing of the RCE papers became necessary to ensure continued pendency of the application. Therefor, refund of the RCE and extension of time fees cannot be effected.

The petition is **DENIED**.

The will be forwarded to Publications Division for printing as a patent.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



Jasemine C. Chambers
Director, Technology Center 1600